

REMARKS

In the Office Action, the Examiner has rejected claims 1-19. Claims 1-19 were previously pending. Applicants have carefully reviewed the Office Action and thank the Examiner for pointing out certain matters that have resulted in the instant clarifications, which should strengthen the application. Applicants have amended claims 1, 4, 5, 11, 14, 15, and 17. Applicants have also canceled claims 9, 10, 12, and 13. Applicants have further added new claims 20-22. The application is now believed to be in condition for allowance. Accordingly, claims 1-8, 11, 14-22 are pending in this application. The application is now believed to be in condition for allowance. Favorable reconsideration is respectfully requested in light of the following Remarks. No new matter has been added.

I. Claim Rejections**A. Rejection of claims 3-5, 11, 17 under 35 U.S.C. § 112**

The Examiner has rejected claims 3-5, 11, and 17 under 35 U.S.C. § 112, second paragraph. More particularly, the Examiner has rejected claims 3-5, 11, and 17 because he was concerned that there is a lack of antecedent basis for the term ‘said second tubular member.’ (see Office Action at page 2, item 3).

Applicants assert that the term “tubular member” is described properly and in detail in the specification and that the term “a second tubular member” is properly introduced in claim 3. Applicants have amended claims 4 and 5 to properly depend from claim 3, where “second tubular member” is introduced. Applicants have amended claim 11 to properly depend from claim 10, where “second tubular member” is introduced. Applicants have also amended claim 17 to properly depend from claim 16, where “second tubular member” is introduced.

Applicants respectfully submit that in view of the amendments to claims 4, 5, 11, and 17, they are now in condition for allowance. This amendment was made for clarification and not for the purpose of altering claim scope. Withdrawal of the rejection is respectfully requested.

B. Rejection of claims 1-7 and 9-12 under 35 U.S.C. § 102(b)

Claims 1-7 and 9-12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,921,203 to Peterson et. al (“Peterson”). Claims 9, 10, and 12 were canceled and the subject matter was incorporated into claims 20-22. Claim 11 was amended to depend from claim 1. The rejection of the remaining pending claims is respectfully traversed.

The Examiner points to Peterson at “*figure 1 upper base 14 with second tubular member 40, dimple 42, lip 36, lower base 22 with first tubular member 24, first isolation layer 16, second isolation layer 18, isolator 60*” (see Office Action at page 3, item 5). To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”¹ “The identical invention must be shown in as complete detail as is contained in the ... claim.”²

The rejection of claims 1-7 and 11 is respectfully traversed for at least the following reasons. Peterson does not teach an isolator 20 and an isolation layer 18 that dampen member 54 from axial vibrations. The first elastically resilient mating ring 16, the second elastically resilient mating ring 18, and the area 60 dampen vibrations in the longitudinal direction of the fastener. Each side of member S of Peterson is not restricted from moving away from the mount, thus causing additional movement and vibration at an adjacent assembly in the radial direction. The claimed invention also includes an annular gap adapted for receiving a tubular portion of a mounting surface, therefore, further restricting the tubular portion of the mounting surface from additional radial vibration.

Additionally, the prior art does not recite a number of the limitations of the dependent claims. For example, isolator 20 and isolation layer 16 may be integrated into one member, reducing manufacturing costs by eliminating additional elements and manufacturing assembly steps, as recited in claim 7. Both isolation layer 18 and isolator 20 serve at least two purposes. Each dampens vibrations in the longitudinal direction of tubular members 22 and 26 and in the

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

radial direction of member 54. The second elastically resilient mating ring 18 in Peterson only effectively dampens in the longitudinal direction of the fastener because it doesn't prevent the mating surface from slipping out of the assembly, thus, the assembly is less efficient than the configuration of the present invention.

Further, it is respectfully submitted that Peterson does not disclose a dimple for engaging a fastener as claimed in dependent claim 5, in contrast with comments made by the Examiner (see Office Action at page 3, item 5). Tube cylindrical portion 42 in Peterson forms a polygon shape when viewed in axial cross section, which in the preferred embodiment is a hexagon (see col. 3, lines 34-37). The tube cylindrical portion is not adapted for engaging a fastener, but is congruent with the shape of the spacer tube portion 26, so that each piece engages the other, and neither the spacer nor the thimble will rotate relative to each other (see col. 3, lines 37-44).

Additionally, Peterson does not disclose a lip as claimed in dependent claim 6 that abuts an isolation layer in contrast with what is stated by the Examiner (see Office Action at page 3, item 5). Annular thimble flange 36 in Peterson is integral with thimble tube 38. The thimble flange 36 is formed with a raised ring 50 located on the axial face opposite the thimble tube 38 (see col. 3, lines 27-29). The thimble flange 36 is planar and does not bend in any way around an isolation layer.

In view of the foregoing, it is respectfully submitted that the indicated claims are in condition for allowance.

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

C. Rejection of claims 1, 2, 7, 9, 14, 15, and 18 under 35 U.S.C. § 102(b)

Claims 1, 2, 7, 9, 14, 15, and 18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,514,811 to Stephenson et. al (“Stephenson”). Claim 9 was canceled and the subject matter was incorporated into claims 20-22. The rejection of the remaining pending claims is respectfully traversed.

The Office Action points to Stephenson at “figure 3 upper base attached to nut 31, lower base 19 with first tubular member unnumbered around screws, first isolation layer 16, second isolation layer 17, isolator attached to first layer 16, annular gap receives tubular portion of mounting surface 14” (see Office Action at page 3, item 6). As stated above, to anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”³ “The identical invention must be shown in as complete detail as is contained in the ... claim.”⁴

The rejection of claims 1, 2, 7, 14, 15, and 18 is respectfully traversed for at least the following reasons. Stephenson does not teach all the elements of the claimed invention. Specifically, Stephenson does not teach using an upper base and a lower base of an assembly having a tubular member. Instead, Stephenson discloses resilient pads or separators that eliminate noise and vibrations between two objects by the use of at least two screws or two screws and a bolt (see Fig. 2 and Fig. 3). In addition, the claimed invention in the form of an assembly includes efficiencies in a manufacturing process that are not taught by Stephenson.

Further, in Stephenson, attachment members 28 and 32 attached to nut 31 are being attached to mounting surface 16 in Fig. 2. Attachment members 28 and 32 are not elements of an assembly in the context of the claimed invention. Attachment members 28 and 32 are components that are attached to a mounting surface 16. Stephenson does not teach or contemplate that attachment members 28 and 32 are part of a mounting assembly in contrast to the suggestion made by the Examiner (see Office Action at page 3, item 6). Additionally,

³ *Verdegaal Bros. v. Union Oil Co. of California*, supra.

⁴ *Richardson v. Suzuki Motor Co.*, supra.

washer-nut 20 in Fig. 2 and washer-nut 19 in Fig. 3 should not be read as a lower base having a tubular member. There seems to be a tubular element disposed between the two fasteners in Fig. 3, but it is a separate element used to secure the upper fastener, the lower fastener, and the washer-nut 19.

However, applicants have amended independent claims 1 and 14 to further clarify the invention. In view of the amendments to claims 1 and 14 and the advantages they provide over the teachings of Stephenson, it is respectfully submitted that claims 1 and 14 are now in condition for allowance. Claims 2 and 7, which depend from claim 1, and claims 15 and 18, which depend from claim 14, are also allowable over the applied art. Withdrawal of the rejection is respectfully requested.

D. Rejection of claims 14-18 under 35 U.S.C. § 103(a)

Claims 14-18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson in view of Stephenson. The rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.⁵

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.⁶ "In determining whether the invention as a whole would have been obvious under section 103, we must first delineate the invention as a

⁵ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

⁶ *Stratoflex, Inc. v. Aeroquip Corp.* , 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)

whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question . . . but also those properties of the subject matter that are inherent in the subject matter and are disclosed in the specification . . . Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention as a whole, and not some part of it, which must be obvious under section 103.⁷

The Examiner acknowledges that Peterson does not teach “*having an annular gap that receives a tubular portion of mounting surface*” (see Office Action at page 3, item 8). The Examiner asserts, however, that “*it would have been obvious to one of ordinary skill in the art at the time the invention was made to have an annular gap that receives a tubular portion of mounting surface as taught by Stephenson et al in the device of Peterson in order to more securely hold the mounting surface than the gap disclosed in Peterson*” (see Office Action at page 3, item 8). The Examiner may not merely state that a specific feature is a design choice but must provide reasoning as to *why* the feature is a design choice. *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

As mentioned above, Peterson does not teach an isolator 20 and an isolation layer 18 that dampens member 54 from axial vibrations. Instead, the first elastically resilient mating ring 16, the second elastically resilient mating ring 18, and the area 60 dampen vibrations in the longitudinal direction of the fastener. Each side of member S is not restricted from moving away from the mount, this causing additional movement and vibration at an adjacent assembly in the radial direction. The claimed invention includes a tubular gap adapted for receiving a tubular portion of a mounting surface, therefore, further restricting the tubular portion of the mounting surface from additional radial vibration.

Both Peterson and Stephenson contemplate mounting a component on a mounting surface by fastening the isolation layers to the opening in steps that include a costly and time-consuming manufacturing process of aligning the openings and fastening both the upper and lower portions of the components to the isolation layers. The present invention reduces the pieces necessary for the fastening of a vibrating component to a mounting surface and allows

⁷ *In re Antonie* , 559 F.2d 618, 195 USPQ 6,8 (CCPA 1977)

fastening of such a component from only one side by utilizing only one fastener.

Nowhere in the prior art of record is there a teaching of the limitations of *amended* claim 14 as discussed above. Moreover, even if Peterson were somehow applicable, at most it teaches the use of isolation layers between mounted components on a vehicular frame for dampening vibrations in the longitudinal direction of a fastener-and-bolt combination. It also includes a complex shape and mechanism that requires an annular segment 102 having holding tabs 104 as shown in Fig.1. The present invention teaches a simple shape and assembly that is more efficient in mounting vibrating components on mounting surfaces from one side while dampening vibration in both the longitudinal and radial directions.

Applicants have, however, amended independent claim 14 to further articulate aspects of the invention. In view of the amendment to claim 14 and the advantages the invention claimed provides over the teachings of Peterson, it is respectfully submitted that claim 14 is now in condition for allowance. Claims 15-18, which depend from claim 14 are also allowable over the applied art. Withdrawal of the rejection is respectfully requested.

E. Rejection of claims 8, 13 and 19 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 8, 13, and 19 under 35 U.S.C. §103(a) as being unpatentable over Peterson in view of U.S. Patent No. 3,390,709 to Schmidt (“Schmidt”). Claim 13 was canceled and the subject matter was incorporated into new claim 22. These two claims are in condition for allowance for the same reasons that their independent claims are.

II. Conclusion

For at least the above reasons, Applicants respectfully submit that the present invention, as claimed, is patentable over the prior art. If the Examiner has any issues that he believes can be expedited by a telephone conference, he is encouraged to telephone the undersigned representative at his earliest convenience.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1638 from which the undersigned is authorized to draw.

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Respectfully submitted,

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